



REMARKS

This is a response to the Office Action dated July 13, 2004. Claims 1-10 are pending in the application and stand rejected.

Summary of Examiner's Action and Response

The Examiner rejected Claims 1-10 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1 and 6 have been amended, and applicant now believes the claims should be allowed.

The Examiner rejected Claims 1-10 under 35 U.S.C. §103(a) as being unpatentable over various prior art references. The Applicant has reviewed these prior art references, and the rejection is respectfully traversed.

Response to Rejection of Claims 1-10 under 35 U.S.C §112, second paragraph

The Examiner rejected Claims 1-10 under 35 U.S.C. section 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

If one skilled in the art would understand the bounds of the claim when read in light of the specification, then the claim satisfies section 112 paragraph 2. Miles Labs., Inc. v. Shandon, Inc., 997 F.2d 870, 875, 27 USPQ2d 1123, 1126 (Fed.Cir.1993).

Applicant has amended the claims 1 and 6 to recite that the top guide and edge guide are structurally connected. Inasmuch that the claims now recite a structural cooperative relationship

between the elements, the Applicant believes that the claims are no longer indefinite. Applicant therefore respectfully submits that the rejection of Claims 1-10 under 35 U.S.C. section 112, second paragraph, should be removed and the claims allowed.

Response to Rejection of Claims 1-10 under 35 U.S.C §103

The Examiner rejected Claim 1 under 35 U.S.C. §103(a) as being unpatentable over Shaw (U.S. 2,603,873) in view of Dickins (U.S. 523,380). The Examiner rejected Claim 2 under 35 U.S.C. §103(a) as being unpatentable over Shaw in view of Dickins, and further in view of Burnett (U.S. 1,448,827). The Examiner rejected Claims 3 and 5 under 35 U.S.C. §103(a) as being unpatentable over Shaw in view of Dickins, and further in view of Nicely (U.S. 5,189,801). The Examiner rejected Claim 4 under 35 U.S.C. §103(a) as being unpatentable over Shaw in view of Dickins, and further in view of Harris (U.S. 5,782,007). The Examiner rejected Claim 6 under 35 U.S.C. §103(a) as being unpatentable over Shaw in view of Burnett. The Examiner rejected Claim 7 under 35 U.S.C. §103(a) as being unpatentable over Shaw in view of Burnett, and further in view of Dickins. The Examiner rejected Claims 8 and 10 under 35 U.S.C. §103(a) as being unpatentable over Shaw in view of Burnett, and further in view of Nicely. The Examiner rejected Claim 9 under 35 U.S.C. §103(a) as being unpatentable over Shaw in view of Burnett, and further in view of Harris. The Applicant respectfully submits that application of section 103 is improper in this case.

It is axiomatic that the prior art to be considered under section 103 must be analyzed in the absence of any teaching from the claimed invention. Such an evaluation requires the often difficult task of excluding anything taught or suggested by the present invention from one's mind. *Loctite Corp. v. Ultraseal Ltd.*, 781 F.2d 861 (Fed.Cir.1985).

In the abstract, this proposition is straightforward. However, courts have often struggled in applying it to relatively simple inventions. This is true because a relatively simple invention - once revealed by its creator - is easily understood. Thereafter, one is prone “to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.” *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed.Cir. 983).

The United States Court of Appeals for the Federal Circuit recently discussed this issue in the case of *In Re Dembiczak*, 175 F.3d 994 (Fed.Cir. 2000), *limited on other grounds by In Re Gartside*, 203 F.3d 1305 (Fed.Cir.2000). *Dembiczak* involved a patent claim on the now-familiar orange trash bags with the printed Jack-O-Lantern faces.

The Dembiczak patent application was rejected by the U.S.P.T.O., then rejected by the Board of Patent Appeals and Interferences. In reversing these decisions, the Federal Circuit noted that “[T]he best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.” *Id.* at 999.

The evidence of a suggestion, teaching, or motivation to combine prior art references must be established in order to set forth a prima facie case of obviousness. *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 297 (Fed.Cir.1985). This evidence must come from the prior art references themselves, the knowledge of one who is skilled in the art, or from the suggestions inherent in the nature of a problem to be solved. *ProMold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573 (Fed.Cir.1996). The suggestion of combination generally comes from the teachings within the references themselves. *In Re Rouffet*, 149 F.3d 1350, 1359 (Fed.Cir.1998).

The Applicant respectfully submits that the requirements for a prima facie case of obviousness

have not been established in this case. Instead, the Applicant suggests that the P.T.O has fallen into the trap the *Dembiczak* opinion warns so sternly against - that of using the inventor's own disclosure to suggest combinations in order to defeat patentability. With the cited authority in mind, the application of section 103 to the various claims will now be discussed in detail.

Claims 1-5

The Examiner rejected Claim 1 under 35 U.S.C. §103(a) as being unpatentable over Shaw (U.S. 2,603,873) in view of Dickins (U.S. 523,380).

The Applicant has reviewed the patent to Shaw and the patent to Dickins, along with all other prior art of which the Applicant is aware and can find no "teaching or motivation to combine prior art references." Simply stated, there is no suggestion in the prior art that one could or that it would be desirable to use the "trough" of Dickins' carpentry rule gauge with the "guide" for cutting glass as taught by Shaw. Absent such a teaching, Applicant respectfully submits that it is improper to combine the references for a 35 U.S.C. section 103 rejection.

In addition, a suggested modification to a reference which destroys the intent, purpose, or function of the invention disclosed in the reference (NOT the invention which forms the subject of the application) does not establish a case of prima facie obviousness. This is true because, in such a case, there would be no motivation to modify the prior art reference in the fashion proposed by the Examiner. *In re Gordon*, 733 F.2d 900 (Fed.Cir. 1984).

The Examiner averred that it would have been obvious to one of ordinary skill to move the opening of Shaw to the upper surface of the device as taught by Dickins so the indicia of the tape could be viewed without obstruction. Shaw, however, teaches a round gauge bar 5 which is fastened to

block 13 by a set screw 17. Employing a trough on the top of block 13 would destroy the functionality of Shaw's invention in that the cutter could not be set to a fixed distance from block 13. As stated by Shaw, "an important object of the invention is to provide an easily attachable gauge which may be secured in position to the stock of a glass cutter to hold the cutter traveling along a straight line while cutting a sheet of glass to the desired width."

Because there is no teaching in the prior art supporting the combination of references and the combination destroys the functionality of the prior art inventions, Applicant respectfully submits that the combination of prior art references for a section 103(a) rejection is improper and claim 1 should be allowed.

Since claims 2-5 depend on claim 1, they should also be allowed. Additionally, Applicant submits independent bases for allowance of the dependent claims below.

With regards to claim 2, Applicant respectfully submits that the Examiner has not shown a teaching in the prior art to suggest combining the thumb holder of Burnett to a combination of the glass cutting gauge of Shaw and the carpentry gauge of Dickins. Applicant believes that the Examiner is using the benefit of hindsight and Applicant's disclosure to combine reconstruct the Applicant's invention from several other inventions when such a teaching is not present in the prior art.

In addition, a prior art reference does not create a case of prima facie obviousness if it fails to disclose a material element or limitation claimed in the present invention. *In re Evanega*, 829 F.2d 1110 (Fed. Cir. 1987). Applicant respectfully submits that the prior art does not include all material elements of limitations claimed in the present invention.

Claim 2 recites that the finger hole passes through the edge guide. Claim 1 describes the edge guide as "positioned to bear against said edge of said object" compared to the top guide which has a

lower surface positioned to “bear against said top surface of said object.” Burnett’s “finger hole” is placed on what at best could be a “top guide” since the guide is designed to bear against the top surface of the object to be sewn. Accordingly, the limitation recited in claim 2 that the finger hole “passing completely through said edge guide” is not present in the prior art references and a rejection under section 103(a) is improper.

Furthermore, the “finger hole” provided in Burnett’s patent is only meant for the tip of the thumb to fit in so as not to cover the view of triangular tongue 23. This is different than the finger loop as recited in claim 2 which is designed to allow the “passage of said user’s index finger therethrough.”

With regards to claims 3 and 5, the Examiner has not shown and the Applicant has not found any teachings in the prior art references to support combining the references. As such, combining the references for a section 103(a) rejection is improper.

Furthermore, a combination of the references does not disclose all of the material limitations recited in claims 3. Specifically, the combination does not teach a “middle finger trough.” Claim 3 recites that the finger guide includes a “middle finger trough positioned to accommodate said user’s middle finger.” As illustrated in Nicely’s patent in FIG. 3 and more clearly in FIG. 8, Nicely’s “trough” is designed to accommodate the user’s index finger. As shown in FIG. 8, the user’s middle finger does not bear against the guide at all.

With regards to claim 4, Applicant respectfully submits that the Examiner has not shown a motivation outside of the Applicant’s disclosure to support the combination of references.

Accordingly, Applicant submits that the rejections of claims 1-5 should be withdrawn and the claims allowed.

Claims 6-10

The Examiner rejected Claim 6 under 35 U.S.C. §103(a) as being unpatentable over Shaw in view of Burnett.

The Applicant has reviewed the patent to Shaw and the patent to Burnett, along with all other prior art of which the Applicant is aware and can find no “teaching or motivation to combine prior art references.” Simply stated, there is no suggestion in the prior art that one could or that it would be desirable to use the “finger hole” of Burnett’s sewing guide with the “guide” for cutting glass as taught by Shaw. Absent such a teaching, Applicant respectfully submits that it is improper to combine the references for a 35 U.S.C. section 103 rejection.

In addition, as described in the remarks regarding claim 2, Burnett teaches placing the “finger hole” on the top guide as opposed to being placed on the edge guide as recited in claim 6. The prior art therefore fails to disclose a material element recited in the claims and a section 103(a) rejection is improper. *In re Evanega*, 829 F.2d 1110 (Fed. Cir. 1987).

Furthermore, as also described in the remarks regarding claim 2, the “finger hole” provided in Burnett’s patent is only meant for the tip of the thumb to fit in so as not to cover the view of triangular tongue 23. This is different than the finger loop as recited in claim 6 which is designed to allow the “passage of said user’s index finger therethrough.”

Since claims 7-10 depend on claim 6, they should also be allowed. Additionally, Applicant submits independent bases for allowance of the dependent claims below.

With regards to claim 7, Applicant respectfully submits that the Examiner has not shown a teaching in the prior art to suggest combining the “trough” of the carpentry gauge of Dickins to the thumb holder of Burnett in combination with the glass cutting gauge of Shaw.

Furthermore, as described in the remarks to claim 1, combining the trough of Dickins with the Shaw's glass cutting gauge would destroy the functionality of Shaw's gauge. A suggested modification to a reference which destroys the intent, purpose, or function of the invention disclosed in the reference does not establish a case of prima facie obviousness. *In re Gordon*, 733 F.2d 900 (Fed.Cir. 1984). Accordingly, Applicant respectfully submits that the section 103(a) rejection is improper with respect to claim 7.

With regards to claims 8 and 10, the Examiner has not shown and the Applicant has not found any teachings in the prior art references to support combining the references. As such, combining the references for a section 103(a) rejection is improper.

Furthermore, a combination of the references does not disclose all of the material limitations recited in claims 8. Specifically, the combination does not teach a "middle finger trough." Claim 8 recites that the finger guide includes a "middle finger trough positioned to accommodate said user's middle finger." As illustrated in Nicely's patent in FIG. 3 and more clearly in FIG. 8, Nicely's "trough" is designed to accommodate the user's index finger. As shown in FIG. 8, the user's middle finger does not bear against the guide at all.

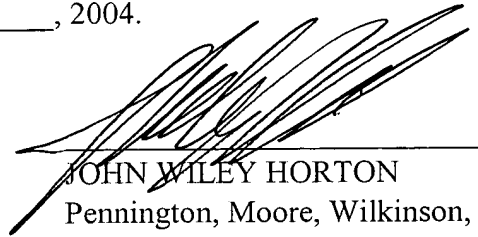
With regards to claim 9, Applicant respectfully submits that the Examiner has not shown a motivation outside of the Applicant's disclosure to support the combination of references.

Accordingly, Applicant submits that the rejections of claims 6-10 should be withdrawn and the claims allowed.

Conclusion

In view of the above amendments and remarks, the Applicant believes that the claims are in condition for allowance. Accordingly, the Applicant respectfully requests that the Examiner reconsider the rejections.

Respectfully submitted this ETH day of Nov., 2004.



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